



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO. 08/015,685	FILING DATE 08/21/97	FIRST NAMED INVENTOR HUFFMAN	ATTORNEY DOCKET NO. 08/015,685
-------------------------------	-------------------------	---------------------------------	-----------------------------------

145170505  
SUGHRUE MION ZINN MACPHEAR & SEAS  
2100 PENNSYLVANIA AVENUE NW  
WASHINGTON DC 20037-3202

EXAMINER HUFFMAN
---------------------

ART UNIT 1722	PAPER NUMBER 21
------------------	--------------------

DATE MAILED: 05/05/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/915,683**

Applicant(s)  
**Fujita et al.**

Examiner  
**Mark F. Huff**

Group Art Unit  
**1752**



☒ Responsive to communication(s) filed on Mar 4, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1 and 5-9 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1 and 5-9 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☒ received in Application No. (Series Code/Serial Number) 08/474,715.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1752

### DETAILED ACTION

1. This Office Action is in response to the amendment filed February 26, 1998 and the declaration under 37 C.F.R. 1.132 filed March 4, 1998.

#### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans et al. (US 4,504,570) in view of either Tanemura et al. (US 5,081,009) or Shuto et al. (US 5,110,719).

Evans et al. (US 4,504,570) teach core/shell tabular grains which may be used in direct positive internal latent image systems. Emulsion B contains grains which have a crystal morphology as presently claimed. The "a" and "b" values claimed in the instant application are comparable to those values obtained from the emulsions of Evans et al. (US 4,504,570). However, the primary reference does not teach the sulfur sensitizer as presently claimed.

Either Tanemura et al. (US 5,081,009) or Shuto et al. (US 5,110,719) disclose sulfur sensitizers that have the presently claimed structures (A), (B) or (C). These sensitizers are

Art Unit: 1752

specifically claimed to be useful for core/shell internal latent image silver halide grains. These compounds are disclosed to provide high sensitivity, low  $D_{\min}$  and high  $D_{\max}$  in silver halide emulsions. See especially Tanemura et al. (US 5,081,009) 2:62-3:5 and the claims; Shuto et al. (US 5,110,719) 2:5-9 and the claims.

It would have been obvious to incorporate the sulfur sensitizers of either Tanemura et al. (US 5,081,009) or Shuto et al. (US 5,110,719) in the grains of Evans et al. (US 4,504,570), since the secondary references specifically teach the use of the sulfur sensitizers in the type of grains taught Evans et al. (US 4,504,570) with the reasonable expectation of achieving core/shell tabular grain emulsion which will have an increased sensitivity and  $D_{\max}$  and a decreased  $D_{\min}$ .

See  
'719  
119-15  
'009  
2:62-65-

#### ***Response to Amendment***

4. In view of the amendments, the rejection under 35 U.S.C. 112, second paragraph, based on parts a. through j. is overcome. Part k. of the rejection is withdrawn since the Examiner misread the claim.

#### ***Response to Arguments***

5. The declaration under 37 CFR 1.132 filed March 4, 1998 is insufficient to overcome the rejection of claims 1 and 5-9 based upon the cited prior art as set forth in the last Office action because: Applicants' claimed addition of compounds (A), (B) or (C) is the preferred embodiment in the secondary references. Tanemura et al. (US 5,081,009) at 11:66-12:2 clearly teach that the

Art Unit: 1752

compounds are preferably added during formation of the core grains and also teach at 5:4-5 that exclusive use of silver bromide is the most preferred and that tabular grains may be used (5:64-68). Shuto et al. (US 5,110,719) provides similar teachings at 7:42-44, 10:52-54, 10:58-63.

Since the references clearly teach the combination as preferable then it would have been expected to gain an improvement in photographic characteristics. This is precisely what Applicants' declaration shows, i.e., the claimed compounds improve the photographic characteristics.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 1752

7. Effective March 9, 1998, Art Unit 1113 has been renumbered as Art Unit 1752. Please refer to **Art Unit 1752** in your response to this Office action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark F. Huff whose telephone number is (703) 308-2464. The examiner can normally be reached on Monday through Friday from 9:30 AM to 5:00 PM.

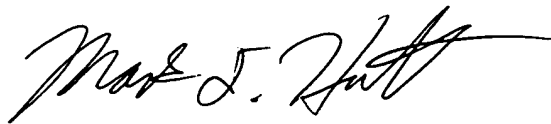
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C. Baxter, can be reached on (703) 308-2303.

The fax telephone numbers for Technology Center 1700 are:

(703) 305-7718 for official papers filed **before** final rejection

(703) 305-3599 for official papers filed **after** final rejection

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 1700 receptionist whose telephone number is (703) 308-0661.



Mark F. Huff  
Primary Examiner  
Art Unit 1752

mfh  
May 4, 1998